



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,548	03/31/2004	Richard Warren Hailey	014586-9012-00	7401

1131 7590 10/17/2006

MICHAEL BEST & FRIEDRICH LLP
Two Prudential Plaza
180 North Stetson Avenue, Suite 2000
CHICAGO, IL 60601

EXAMINER

VEILLARD, JACQUES

ART UNIT	PAPER NUMBER
2165	

DATE MAILED: 10/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/814,548

Applicant(s)

HAILEY ET AL.

Examiner

Jacques Veillard

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/5/06, 6/12/06, 7/19/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the applicant's communication filed on 03/31/2004.
2. Claims 1-24 are pending and presented for examination.

Information Disclosure Statement

3. The information disclosure statement filed 07/19/2004 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because a number of references listed on the 1449B form fail to list the reference publishing's date. According, it has been placed in the application file, but the information referred to therein has been considered as to the merits. However, the strikethrough references in the form have been considered because they do not have a published date.

Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "195" has been used to designate both "keyword set, and instruction" in Fig.12 and "table" in Fig.13; reference character "370" has been used to designate "compositioninfo type", "front type", "field modifiers", and "field table" in Fig.22. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and

Art Unit: 2165

informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: elements “190, 192” in Fig.12; data table 330 and data targets 332 in Fig.19. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: “data table 330” and “data targets 332” in Fig.19. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement

Art Unit: 2165

Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 3-9, 12-13, 18 and 23-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The pronoun “that” recited in lines 12 and 14 of claim 3; in line 3 of claim 8; in line in lines 15 and 17 of claim 12; in lines 21 and 22 of claim 21, and the pronoun “it” recited in line 23 of claim 6, in line 11 of claim 18 render the claims indefinite. The pronouns “that” and “it” are not permitted as part of the claimed language only what is being referred by “that” and “it” should be set forth in the claim. Appropriate correction or deletion is required.

As per claims 4, 5, 7, 9, and 13, they are, at least rejected due to their dependencies directly or indirectly on the rejected claims 3 and 12 above.

The feature “so that” recited in line 8 of claim 23, and in line 10 of claim 24 renders the claims indefinite. The feature “so that” is not defined by the claims, and the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonable appraised of the scope of the invention. Due to the different meanings

of “so”, it is unclear what applicant meant by “so that” in the claims. Furthermore, the pronoun “that” is not permitted as part of the claimed language; only what is being referred by “that” should be set forth in the claim.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 1-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, specifically directed towards a non-functional descriptive material, per se. The wording of claims 1 and 11 as written raises questions. The claims recite a knowledge base to store data structure. In particular, it appears that the knowledge base only includes non-functional descriptive, data per se. What’s included in the knowledge base (i.e., data structure with objects and content) does not appear to meet the IEEE definition of data structure, and no instruction for causing functionality that results in a practical application appears to be present. As such, claims 1 and 11 appear to be solely non-functional descriptive material included in the knowledge base and therefore, non-statutory.

As per claims 2-10, and 12-13, they are, at least rejected for their dependencies directly or indirectly, on the rejected claims 1 and 11 above.

11. Claims 14-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 14-24 appear to be directed to an abstract idea rather than a practical application of the idea. The claims do not result in a physical transformation, nor

Art Unit: 2165

do they appear to provide a useful, concrete and tangible result. The claimed steps of “overriding...” and “transforming...” do not produce any output result. The final result achieved appears to be overriding (i.e., editing) objects and transforming a tree into a data structure. Thus, that is not a physical transformation; therefore, it must achieve a useful, concrete and tangible result to statutory. The overriding and transforming are not claimed as applied in a practical application, which provides a tangible, i.e., real world result. Instead, it appears to remain a mere abstraction. Therefore, the claims are not statutory and rejected under 35 U. S. C. 101.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1, 2, 4, 6, 7, and 11 rejected under 35 U.S.C. 103(a) as being unpatentable over Poole et al. (U. S. Pat. No. 6006,242) in view of Bantz et al. (U. S. Pub. No. 2003/0163809).

As per claims 1 and 11, Poole et al. disclose a system comprising: a knowledge base configured to be coupled to a data structure assembly facility (See Poole et al. Figs.3, 4, and col.6, lines 15-63), each object configurable to have a precedence (See Poole et al. col.5, lines 44-52, and col.6, lines 55-63), to include one or more rules, and to include content (See Poole et al. col.6, lines 17-34). Even though, the system discloses by Poole et al is described within the context of an object programming implementation and a knowledge base that acts as a database for storing information (See Poole et al. col.6, lines 6-28)

Art Unit: 2165

It is noted, however, Poole et al. did not specifically disclose the knowledge base configured to store data structure components as objects in an object-relational hierarchy. On other hand, Bantz et al. achieved this claimed features by providing a system wherein the knowledge base is organized as a database including object-relational for storing data object (See Bantz et al. page 4, paragraph [0039], lines 6-10).

It would have been obvious to a person of ordinary skill in the art at the time the applicant's invention was made to combine Poole et al.'s system with Bantz et al.'s system because the system disclosed by Bantz et al. provides a database as object relational which is allowing users or developers using the system of Poole et al. to integrate the database with their custom data and enable them to use the knowledge databases to scan in order to find applicable rule (See Bantz et al. Fig.6, and page 3, paragraph [0037], lines 4-5).

As per claim 2, the combination of Poole et al. and Bantz et al. discloses the claimed limitations, wherein the precedence provides hierarchical control of content to match business preferences (S see Poole et al. col.5, lines 3-52, col.6, line 55-63).

As per claim 4, the combination of Poole et al. and Bantz et al. discloses the claimed limitations, further comprising a data structure assembly facility (See Poole et al. Figs.1, 3 and 4 which disclose the generation of data or document by assembling the components, and col.5, lines 1-24).

As per claim 6, the combination of Poole et al. and Bantz et al. discloses the claimed

Art Unit: 2165

limitations, wherein the assembly facility is operable to, when a object having a rule is encountered, evaluate the rule and replace it with a value (See Poole et al. col. 12, lines 47-52).

As per claim 7, the combination of Poole et al. and Bantz et al. discloses the claimed limitations, further comprising an authoring tool and a content management system (See Poole et al. 6, lines 17-34).

Prior Art Made of Record

14. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. U.S. patents and U.S. patent application publications will not be supplied with Office actions. Examiners advises the Applicant that the cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site (www.uspto.gov), from the Office of Public Records and from commercial sources. For the use of the Office's PAIR system, Applicants may refer to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197.

Points Of Contact

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacques Veillard whose telephone number is (571) 272-4086. The examiner can normally be reached on Mon. to Fri. from 9 AM to 4:30 PM, alt. Fri. off..

Art Unit: 2165

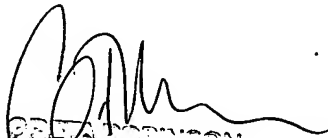
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (571) 272- 4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


J.V

Jacques Veillard
Patent Examiner AU 2165

October 11, 2006


GREG ROBINSON
PRIMARY EXAMINER